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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,434	11/13/2001	Randhir P.S. Thakur	1450.001US1	3036

21186 7590 04/18/2006		EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402		THAI, CANG G	
		ART UNIT	PAPER NUMBER
		3629	

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/008,434	THAKUR, RANDHIR P.S.
	Examiner	Art Unit	
	Cang G. Thai	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 February 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-31</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-31</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

This is in response to an amendment file on 02/09/2006 for letter for patent filed

on 11/13/2001. Claims 1-31 are pending in the letter.

Response to Arguments

1.   The United States Patent and Trademark Offices has considered applicant's

arguments filed 02/09/2006, but has not found those arguments to be persuasive.

Applicant argues that the prior art fails to teach the aspects of the structure of

database, search facilities via a network for potential customers, potential customers

can search via a network, database available to unrelated parties, and making

information available to selective independent customers via network connection. In

particular, HUNTER teaches the searching capability as provided by a database via a

network by potential customers and independent customers (Column 4, Lines 21-32).

The system allows the user to select the technology management activity that he/she

wants to accomplish next. Examples of technology management activities include the

following: record progress, search prior art, create/edit disclosure, evaluate invention,

file patent application, market invention and prepare agreements. The system allows a

user to select an existing disclosure from, or add a new disclosure to, an invention

database. When adding a new disclosure the user is able to select a disclosure

purpose. The user is also able to select an invention category, such as the following:

(1) product, and (2) process.

Status of Claims

Claims 1-31 have been examined.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 1-31 are rejected under 35 U.S.C. 102(e) as being anticipated by US

Patent No. 6,298,327 (HUNTER ET AL).

As for claim 1, HUNTER discloses a system for facilitating use of inventions in

accordance with a business model, the system comprising:

a server coupled to a network for receiving descriptions of inventions {See Fig. 1,

Element 21 and Column 17, Lines 62-63, wherein this reads over "a client class sends a

message to a server class requesting assistance in fulfilling a client responsibilities"}.

a classification module for classifying inventions into predetermined classes {See

Fig. 1, Element 3 and Column 17, Lines 53-54, wherein this reads over "candidates for

abstract super classes are identified by grouping classes that share common

attributes"};

an evaluation module for providing evaluations of the inventions {Column 8,

Lines 14-16, wherein this reads over "such an evaluation is necessary because

preparation, filing, and prosecution of patent applications can be time-consuming and

expensive}; and

a database for storing the descriptions of inventions and evaluations by class and

providing search facilities via the network for potential customers not related to the

innovators to find inventions {See Fig. 2, Element 32 and Column 24, Lines 60-62,

wherein this reads over "abstract subclass Records Databases 31 and abstract

subclass Text Files Databases 33 inherit behavior (member functions or methods) from

super class Databases 32"}.

As for claim 2, HUNTER discloses the system of claim 1 wherein the evaluations

are selected from the group consisting of prior art searches, technical feasibility reviews,

commercial viability analysis and legal evaluation {Column 24, Lines 33-35, wherein this

reads over "based on this evaluation, the form(s) of representation that best matched

the inherent structure(s) of the problem are identified"}.

As for claim 3, HUNTER discloses the system of claim 1 wherein the server

further comprises a facilitator for controlling interaction between innovators and potential

customers {Column 17, Lines 62-63, wherein this reads over "a client class sends a

message to a server class requesting assistance in fulfilling a client responsibility"}.

As for claim 4, HUNTER discloses the system of claim 3 wherein the facilitator

provides for potential customers to fund intellectual property protection for inventions

{Column 2, Lines 47-50, wherein this reads over "the disclosure must allow the

technology manager and/or research sponsor to decide whether to invest in protecting

the invention"}

As for claim 5, HUNTER discloses the system of claim 3 wherein the facilitator provides the ability to refine inventions based on evaluations {Column 17, Lines 8-10, wherein this reads over "the application contains an analysis of the problems involved with (or limitation of) the prior art that are solved by the invention"}.

As for claim 6, HUNTER discloses the system of claim 3 wherein the facilitator controls access to a selected group of potential customers {Column 2, Lines 43-47, wherein this reads over "expert support system software that enables inventors to adequately disclose (communicate) the characteristics of their inventions to their technology manager and research sponsor, as well as their patent professional (i.e., patent attorney or patent agent)"}.

As for claim 7, HUNTER discloses the system of claim 1, wherein an owner of the system is provided rights to royalty on the inventions {Column 2, Lines 50-55, wherein this reads over "if protection is sought, it must be complete enough for the patent professional to be able to determine whether patent protection is appropriate and, if so, to be used as a basis for preparation and prosecution of a patent application"}.

As for claim 8, HUNTER discloses the system of claim 1 and further comprising a translation module that translates descriptions of inventions {Column 3, Lines 14-17, wherein this reads over "because domain knowledge can be complex and its language "foreign," exchanges of information are typically clarified by guidance, explanations, and examples"}.

As for claim 9, HUNTER discloses the system of claim 1 wherein the database

also contains indications of issued patents on inventions {Column 18, Lines 19-21,

wherein this reads over "database classes responsible for managing databases

comprises of the text file names are described in Table 4"}.

As for claim 10, HUNTER discloses the system of claim 1 wherein the server

further screens and validates descriptions of inventions {Column 17, Lines 29-31,

wherein this reads over "comparative data on the results of the invention compared to

the results of the prior art are presented"}.

As for claim 11, HUNTER discloses a computer implemented business model

method of facilitating the use and protection of inventions, the model method

comprising:

receiving descriptions of inventions {Column 3, Lines 12-14, wherein this reads

over "each expert participating in such an interaction provides information about his/her

domain and receives information about the other expert's domain"};

categorizing the inventions {See Fig. 1, Element 3 and Column 17, Lines 53-54,

wherein this reads over "candidates for abstract super classes are identified by grouping

classes that share common attributes"};

evaluating the inventions for potential licensing value {Column 8, Lines 14-16,

wherein this reads over "such an evaluation is necessary because preparation, filing,

and prosecution of patent applications can be time-consuming and expensive"};

providing a database containing the inventions and evaluations {See Fig. 2,

Element 32 and Column 24, Lines 60-62, wherein this reads over "abstract subclass

Records Databases 31 and abstract subclass Text Files Databases 33 inherit behavior

(member functions or methods) from super class Databases 32"}; and

making the database selectively viewable to potential customers of the inventions

who are not related to the innovators {Column 18, Lines 30-31, wherein this reads over

"expert (or knowledge-based) objects are also key components of domain-interaction

system"}.

As for claim 12, HUNTER discloses the method of claim 11 wherein evaluating is

performed with respect to prior art searches, technical feasibility reviews, commercial

viability analysis and legal evaluation {Column 24, Lines 33-35, wherein this reads over

"based on this evaluation, the form(s) of representation that best matched the inherent

structure(s) of the problem are identified"}.

As for claim 13, HUNTER discloses the method of claim 12 wherein and further

comprising controlling interaction between innovators and potential customers {Column

17, Lines 62-63, wherein this reads over "a client class sends a message to a server

class requesting assistance in fulfilling a client responsibility"}.

As for claim 14, HUNTER discloses the method of claim 12 wherein controlling

interaction between innovators and potential customers comprises providing anonymity

of at least one of the innovators and potential customers {Column 17, Lines 62-63,

wherein this reads over "a client class sends a message to a server class requesting

assistance in fulfilling a client responsibility"}.

As for claim 15, HUNTER discloses the method of claim 12 and further

comprising providing for potential customers to fund intellectual property protection for

inventions {Column 2, Lines 47-50, wherein this reads over "the disclosure must allow

the technology manager and/or research sponsor to decide whether to invest in

protecting the invention"}

As for claim 16, HUNTER discloses the method of claim 12 and further

comprising providing the ability to refine inventions based on evaluations {Column 17,

Lines 8-10, wherein this reads over "the application contains an analysis of the

problems involved with (or limitation of) the prior art that are solved by the invention"}.

As for claim 17, HUNTER discloses the method of claim 11 and also comprising

providing indications of issued patents on inventions {Column 18, Lines 19-21, wherein

this reads over "database classes responsible for managing databases comprises of the

text file names are described in Table 4"}.

As for claim 18, HUNTER discloses the method of claim 11 and further

comprising screening and validating descriptions of inventions {Column 30, Lines 40-42,

wherein this reads over "validation was carried out to determine if the prototype

performed the critical real-world tasks for which it was created"}.

As for claim 19, HUNTER discloses the method of claim 11 and further

comprising controlling access to a selected group of potential customers {Column 17,

Lines 62-63, wherein this reads over "a client class sends a message to a server class

requesting assistance in fulfilling a client responsibility"}.

As for claim 20, HUNTER discloses the method of claim 11 and further

comprising providing rights to royalty on the inventions {Column 2, Lines 50-55, wherein

this reads over "if protection is sought, it must be complete enough for the patent

professional to be able to determine whether patent protection is appropriate and, if so, to be used as a basis for preparation and prosecution of a patent application"}.

As for claim 21, HUNTER discloses the method of claim 11 and further comprising translating descriptions of inventions to desired languages {Column 3, Lines 14-17, wherein this reads over "because domain knowledge can be complex and its language "foreign," exchanges of information are typically clarified by guidance, explanations, and examples"}.

As for claim 22, HUNTER discloses a method of facilitating invention in accordance with a business model, the method comprising:

receiving invention input from multiple independent innovators coupled by network {Column 3, Lines 12-14, wherein this reads over "each expert participating in such an interaction provides information about his/her domain and receives information about the other expert's domain"};

validating the invention input {Column 30, Lines 40-42, wherein this reads over "validation was carried out to determine if the prototype performed the critical real-world tasks for which it was created"};

categorizing the invention input into discrete technical categories {See Fig. 1, Element 3 and Column 17, Lines 53-54, wherein this reads over "candidates for abstract super classes are identified by grouping classes that share common attributes"};

evaluating the invention input {Column 8, Lines 14-16, wherein this reads over "such an evaluation is necessary because preparation, filing, and prosecution of patent applications can be time-consuming and expensive"};

providing a recommendation based on the evaluations {Column 24, Lines 33-35, wherein this reads over "based on this evaluation, the form(s) of representation that best matched the inherent structure(s) of the problem are identified"}; and

making the invention input and recommendation available to selective independent customers via network connection {Column 17, Lines 8-10, wherein this reads over "the application contains an analysis of the problems involved with (or limitation of) the prior art that are solved by the invention"}.

As for claim 23, HUNTER discloses the method of claim 22 wherein evaluating is based on at least one of prior art searching, technical feasibility, commercial viability and legal evaluation {Column 24, Lines 33-35, wherein this reads over "based on this evaluation, the form(s) of representation that best matched the inherent structure(s) of the problem are identified"}.

As for claim 24, HUNTER discloses the method of claim 22 and further comprising facilitating protection of and invention by involving a potential customer to provide funding for such protection in exchange an interest in the invention {Column 2, Lines 47-50, wherein this reads over "the disclosure must allow the technology manager and/or research sponsor to decide whether to invest in protecting the invention"}.

As for claim 25, HUNTER discloses the method of claim 24 wherein at least some of the elements are performed by humans {Column 3, Lines 12-14, wherein this reads over "each expert participating in such an interaction provides information about his/her domain and receives information about other expert's domain"}.

As for claim 26, HUNTER discloses the method of claim 22 and further comprising controlling access to a selected group of potential customers {Column 2, Lines 43-47, wherein this reads over "expert support system software that enables inventors to adequately disclose (communicate) the characteristics of their inventions to their technology manager and research sponsor, as well as their patent professional (i.e., patent attorney or patent agent)"}.

As for claim 27, HUNTER discloses the method of claim 22 and further comprising providing rights to a royalty on the inventions {Column 2, Lines 50-55, wherein this reads over "if protection is sought, it must be complete enough for the patent professional to be able to determine whether patent protection is appropriate and, if so, to be used as a basis for preparation and prosecution of a patent application"}.

As for claim 28, HUNTER discloses the method of claim 22 and further comprising translating descriptions of inventions to desired languages {Column 3, Lines 14-17, wherein this reads over "because domain knowledge can be complex and its language "foreign," exchanges of information are typically clarified by guidance, explanations, and examples"}.

As for claim 29, which has the same limitations as in claim 1, therefore, it is rejected for the similar reasons set forth in claim 1.

As for claim 30, which has the same limitation as in claim 3, therefore, it is rejected for the similar reason set forth in claim 3.

As for claim 31, HUNTER discloses a computer readable medium having instructions thereon for causing a server computer to execute a method of facilitating invention, the method comprising:

receiving invention input from multiple independent innovators coupled by network {Column 3, Lines 12-14, wherein this reads over "each expert participating in such an interaction provides information about his/her domain and receives information about the other expert's domain"};

facilitating validation of the invention input {Column 30, Lines 40-42, wherein this reads over "validation was carried out to determine if the prototype performed the critical real-world tasks for which it was created"};

facilitating categorization of the invention input into discrete technical categories { See Fig. 1, Element 3 and Column 17, Lines 53-54, wherein this reads over "candidates for abstract super classes are identified by grouping classes that share common attributes"};

facilitating evaluation of the invention input {Column 8, Lines 14-16, wherein this reads over "such an evaluation is necessary because preparation, filing, and prosecution of patent applications can be time-consuming and expensive"};

facilitating the provision of a recommendation based on the evaluations {Column 24, Lines 33-35, wherein this reads over "based on this evaluation, the form(s) of representation that best matched the inherent structure(s) of the problem are identified"}; and

facilitating the making of the invention input and recommendation available to selective independent customers via network connection {Column 17, Lines 8-10, wherein this reads over "the application contains an analysis of the problems involved with (or limitation of) the prior art that are solved by the invention"}.

Conclusion

4.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cang (James) G. Thai whose telephone number is (571) 272-6499. The examiner can normally be reached on 6:30 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CGT
03/07/2006

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